REMARKS

In the Office Action dated January 26, 2007, the Examiner states that upon reconsideration, the previous suspension of the application has been withdrawn. The Examiner has reinstated the rejection under 35 U.S.C. §102(e) based on U.S. Application Publication 2002/0169299 by Slaugenhaupt, because the Examiner contends that Applicants' Declaration previously filed under 37 C.F.R. §131 is insufficient to antedate the '299 publication. Therefore, the Examiner has rejected claims 1-6 and 14-17 under 35 U.S.C. §102(e) as allegedly anticipated by the '299 publication. The Examiner has also rejected claims 7 and 8 under 35 U.S.C. §103(a) as allegedly unpatentable over the '299 publication. Additionally, the Examiner has rejected claim 13 under 35 U.S.C. §103(a) as allegedly unpatentable over the '299 publication in view of Ahren (*The Scientist* 19(155): 20-24, 1995).

With respect to the §102(e) rejection of claims 1-6 and 14-17 based on the '299 publication, Applicants first respectfully submit that claims 3-8 and 13-17 were pending before the Examiner. Therefore, Applicants believe that the Examiner's reference to claims 1-6 and 14-17 in the Action was in error.

Regarding the merits of the §102(e) rejection, the Examiner states that the Declaration field on May 12, 2005 under 37 C.F.R. §1.131 has been considered but is ineffective to overcome the '299 publication. The Examiner contends that an affidavit or declaration is inappropriate under 37 C.F.R. §1.131(a) when the reference, i.e., the '299 publication, is claiming the same patentable invention. The Examiner further states that if the reference and this application are not commonly owned, the reference can only be overcome by establishing priority of invention through an interference proceeding. The Examiner has directed Applicants' attention to MPEP 2306.

In response, Applicants respectfully submit that the relevant provisions in MPEP do not support the Examiner's position. Specifically, MPEP 2305-I states:

> "Ordinarily an Applicant may use an affidavit of prior invention under 37 C.F.R. §1.31 to overcome a rejection under 35 U.S.C. §102(a) or 102(e). An exception to the rule arises when the reference is a patent or application published under 35 U.S.C. §122(b) and the reference has claims directed to *the same patentable invention* as the application claims being rejected." (Emphasis added.)

Here, the Examiner has not established that the '299 publication and the present application are directed to the same patentable invention.

In this connection, Applicants respectfully submit that the claims that matter for the purpose of 37 C.F.R. §1.131 are not the published claims but the currently existing claims. See MPEP 2305-I. Applicants observe that the claims in the application underlying the '299 publication, Serial No. 10/041,856, have been significantly amended since the publication of the application. As of the filing of this Response, the pending claims of the '856 application are directed to certain oligonucleotides and related kits. Applicants further observe that in a Restriction Requirement issued June 17, 204 in the '856 application, the Examiner has stated that a method for detecting a mutation in a protein (Group IV), and isolated nucleic acids including oligonucleotides (Group I), are separate and distinct inventions. The applicant in the '856 application elected and has been prosecuting the subject matter of Group I. In contrast, the presently claimed methods are directed to determination of the presence of a polymorphism associated with familial dysautonomia by detecting either or both of two nucleotide changes in the gene encoding the IκB kinase-complex-associated protein. Applicants respectfully submit that based on the reasoning provided in the Restriction Requirement issued in the '856 application, the claims of the present application and the claims drawn to nucleic acids presently pending in the '856 application, are not the same patentable subject matter.

Therefore, Applicants respectfully submit that the premise for the Examiner's refusal to consider Applicants' 131 Declaration is invalid.

Furthermore, Applicants respectfully submit that the claims of the '856 application are not in condition for allowance. Applicants also observe that the applicant of the '856 application filed a divisional application, in which claims directed to methods of detecting a mutation are presented but have not yet been examined on the merits. In this regard, Applicants observe that it is stated in MPEP 2305-I:

> "[I]f a published application contains claims to the same invention, but the claims in the published application are not in condition for allowance, then no interference is yet possible. 37 C.F.R. 41.102. Since the claims in the published application might never be allowed in their present form, it is not appropriate to proceed as though an interference would be inevitable. Consequently, an affidavit under 37 C.F.R. §1.131 may be submitted."

Therefore, Applicants respectfully submit that neither the '856 application nor its divisional application is in condition for allowance. Under the circumstances, it is proper and permissible for Applicants to submit a §131 Declaration and antedate the '299 publication.

In view of the foregoing, it is respectfully submit that the §131 Declaration previously submitted is effective to over the §102(e) rejection based on the '299 publication. Withdrawal of the rejection is therefore respectfully requested.

Furthermore, it is respectfully submitted that the §103(a) rejections based on the '299 publication as the primary reference no longer stand. Withdrawal of these rejections is also respectfully requested.

In view of the foregoing amendments and remarks, it is firmly believed that the subject application is in condition for allowance, which action is earnestly solicited.

Respectfully submitted,

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